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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,692	05/25/1999	SUBAN G. KRISHNAMOORTHY	PD98-2385	1777

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EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/318,692

Applicant(s)

KRISHNAMOORTHY ET AL.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-49 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-49 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06042004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Cancellation of claims 35-44 and 50-54 and amendment of claim 45 is noted. Claims 45-49 and 55 remain pending.
2. The Examiner would like to note that the present application has been reassigned to a new Examiner. Upon further consideration of the application, the indication of allowable subject matter, made in the Office action of 1/4/2005, has been withdrawn, as discussed below. While the Examiner appreciates the inconvenience that such action may cause Applicant and apologizes on behalf of the Office, the Examiner cannot simply look away in the presence of evidence showing unpatentability of the present claims.
3. Upon further consideration by the Examiner, the declaration filed on 10/5/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ohara et al. (US 6,438,643; US 6,694,376) and Hayes Jr. et al. (US 6,105,066) references.
4. It appears that Applicant intends to show invention of the claimed matter prior to the May 5, 1998 date established by the Hayes, Jr. et al. (US 6,105,066) reference, which also predates the January 19, 1999 date established by both Ohara et al. references, by showing actual reduction to practice prior to May 5, 1998.

I. Reduction to Practice

5. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date (May 5, 1998) of the Hayes Jr. et al. reference. Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

6. The affidavit or declaration and exhibits submitted by Applicant must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts to essentially a mere pleading, unsupported by proof or a showing of the facts", and, thus, does not satisfy the requirements of 37 CFR 1.131(b). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by Applicant. (See MPEP 715.07, 1).

7. With regard to the declaration, merely alleging that "The attached declaration establishes inventive and reduction to practice dates prior to May 5, 1998" is not sufficient. Applicant must give a clear explanation of the exhibits, pointing out exactly what facts are established and relied upon by Applicant.

Applicant merely refers to the attached document by stating "attached to this declaration is a redacted invention disclosure document, which predates the filing data

of the two Ohara patents and the Hayes Patents", further alleging that "The attached declaration establishes inventive and reduction to practice dates prior to May 5, 1998". It is unclear if the "attached declaration" is supposed to be the invention disclosure document, the declaration in which the statement is contained, or another document entirely. It appears that the "attached declaration" referred to by Applicant is the "invention disclosure statement", and it has been interpreted as such for the analysis of the declaration.

8. With regard to the attached "invention disclosure document", the description of the document is insufficient. No description of the document is contained within the declaration. The Examiner cannot find any evidence of either conception or reduction to practice upon review of the document.

At most, the document appears to contain a list of contributing inventors, a series of figures which are similar, but not identical to, some of the figures originally filed with the present application. However, the flowchart on page 20 is illegible, and the differences between that flowchart and Fig 10 in the originally filed application cannot be ascertained. The lack of accompanying description does not allow a complete analysis of the facts without requiring speculation as to the meaning and content of the document.

At best, the document may provide some evidence that a draft application existed on 12/1/97, but the evidence is not sufficient to show either conception or reduction to practice of the claimed invention.

9. It should be noted that the same evidence sufficient for a constructive reduction to practice may be insufficient to establish an actual reduction to practice, which requires a showing of the invention in a physical or tangible form. For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose. A process is reduced to practice when it is successfully performed. (See MPEP 2138.05).

Applicant has failed to provide any evidence of testing which shows that the invention was complete and worked for its intended purpose or any evidence which shows that the claimed method was actually performed prior to the critical date of May 5, 1998.

10. For at least the reasons cited above, the declaration and exhibits are inadequate to establish actual reduction to practice prior to May 5, 1998.

Allowable Subject Matter

11. The indicated allowability of claims 45-49 and 55, if they were rewritten in independent form, including all of the limitations of the base claim and any intervening claims, is withdrawn.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 45,46,48,49, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohara et al. (US 6,438,643).

14. In referring to claim 45, Ohara shows:

receiving at a server, a request from a client to update firmware file on one or more storage devices in the computer system (col. 15 lines 60-63).

instantiating an agent (information obtaining routine) on the server;

registering the agent with an agent manager (manager G) (col. 16 lines 13-17).

transmitting from the server to the client a first list of storage devices visible to the server (col. 15 lines 60-63);

receiving from the client a second list of storage devices including at least one storage device from the first list of storage devices, a firmware file,

instructing and process for initiating to download the firmware file to the at least one storage device on the second list of storage devices (col. 14 lines 64- col. 15 line 10).

15. In referring to claim 46, Ohara shows agent manager (manager G) periodically pings the agent instantiated on the server, and un-registers the agent if the agent is unavailable (col. 15 lines 66- col. 16 line 12).

16. In referring to claim 48, Ohara shows, validating at least one storage device on the second list comprises storing a device identifier associated with a validating device in a data field in the firmware file (col. 16 lines 24-26).

17. In referring to claim 49, Ohara shows identifying storage devices visible to the server comprises scanning a peripheral bus (col. 16 lines 1-12).

18. In referring to claim 55, Ohara shows, agent monitors a storage device and reports a storage device status change to a client (status 103, fig. 7).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara (US 6,438,643) in view of Hayes Jr. (US 6,105,066).

21. Although Ohara (US 6,438,643) shows substantial features of the claimed invention including validating the client with the agent manager (fig. 3 col. 18 lines 4-21), Ohara does not show applet executing on client. Nonetheless this feature is well known in the art, and would have been an obvious modification to the system disclosed by Ohara as evidenced by Hayes.

In an analogous art, Hayes shows a system for central application management, where in established communications connection is between agent and an applet executing on client (col. 6 lines 15-58). Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Ohara to employ the features shown by Hayes, in order to run downloads on a users Java enabled web browser.

Conclusion

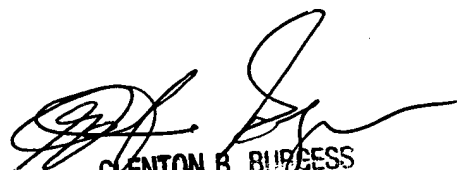
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS
6/21/2005



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